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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/433,139	11/03/1999	JOHN G. SAVAGE	8184.00	2123

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MICHAEL CHAN
NCR CORPORATION
101 WEST SCHANTZ ECD-2
DAYTON, OH 454790001

EXAMINER

PARTON, KEVIN S

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 08/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/433,139	SAVAGE ET AL.	
	Examiner	Art Unit	
	Kevin Parton	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4-5</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Drawings

1. The drawings are objected to because several figures have parts that should be labeled in the diagram. The following list shows the figures and corresponding part numbers that apply:

- a. Figure 3, parts 30, 32, 44, 46, 12a
- b. Figure 5, parts 30, 52, 54, 56, 12b
- c. Figure 6, parts 74, 76, 84, 86, 88, 20
- d. Figure 7, parts 30, 32, 44, 46, 12a, 90, 92

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiota et al. (USPN 6,337,712).

4. Regarding claim 1, Shiota et al. (USPN 6,337,712) teach a self service terminal system comprising:

- a. A digital data port for enabling interchange of digital data between the terminal and a portable digital device having a corresponding matching port and presented by a customer (figure 2; column 5, lines 19-23).
- b. Digital data transfer means for transferring data between the port and a digital data network (figure 3). Note that in the reference, the user inputs into a coin operated kiosk and the data is transported via a wireless network to a common server.

5. Regarding claim 2, Shiota et al. (USPN 6,337,712) all the limitations as applied to claim 1. They further teach means wherein the port comprises a wireless port (figure 2, item 5; column 6, lines 65-67).

6. Regarding claim 5, Shiota et al. (USPN 6,337,712) teach a self service terminal system comprising:

- a. A digital data port for enabling interchange of digital data between the terminal and a portable digital device having a corresponding matching port and presented by a customer (figure 2; column 5, lines 19-23).
- b. A digital data transfer device which transfers data between the port and a digital data network (figure 3). Note that in the reference, the user inputs into

a coin operated kiosk and the data is transported via a wireless network to a common server.

7. Regarding claim 6, Shiota et al. (USPN 6,337,712) all the limitations as applied to claim 1. They further teach means wherein the port comprises a wireless port (figure 2, item 5; column 6, lines 65-67).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. (USPN 6,337,712) in view of Cheung et al. (USPN 5,953,507).

10. Regarding claims 3 and 7, Shiota et al. (USPN 6,337,712) teach means for receiving data on an infra-red carrier signal (figure 2, item 5; column 6, lines 65-67).

11. Regarding claims 3 and 7, although the system disclosed by Shiota et al. (USPN 6,337,712) (as applied to claims 1 and 5, respectively) shows substantial features of the claimed invention, it fails to disclose means wherein the port includes means for transmitting data on an infra-red carrier signal.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Shiota et al. (USPN 6,337,712), as evidenced by Cheung et al. (USPN 5,953,507).

In an analogous art, Cheung et al. (USPN 5,953,507) discloses a system for transferring data from a portable digital device to a stationary device comprising means wherein the port includes means for transmitting data on an infra-red carrier signal (figure 2; figure 3, column 9, lines 15-30). Note that the reference teaches requests from the portable device through the stationary device with information and files returned. Also, the three-way bridge in the reference shows data being passed to and from the portable digital device via the infra-red link.

Given the teaching of Cheung et al. (USPN 5,953,507), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Shiota et al. (USPN 6,337,712) by employing the receipt and transmission of data via the infrared wireless link. The system would benefit by being able to respond to the user with status and location of delivered files. Also, in credit card situations, the system could return an electronic receipt to avoid the waste of paper and printing resources.

12. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. (USPN 6,337,712) in view of Slotznick (USPN 6,108,640).

13. Regarding claims 4 and 8, although the system disclosed by Shiota et al. (USPN 6,337,712) (as applied to claims 1 and 5, respectively) shows substantial features of the claimed invention, it fails to disclose means wherein the terminal is operable to interact with the personal digital device such that the terminal is operable to read personal information from the portable digital device, and thereby build a profile of the customer.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Shiota et al. (USPN 6,337,712), as evidenced by Slotznick (USPN 6,108,640).

In an analogous art, Slotznick (USPN 6,108,640) discloses a system for interaction of a portable digital device with a digital network including self service terminals comprising means wherein the terminal is operable to interact with the personal digital device such that the terminal is operable to read personal information from the portable digital device, and thereby build a profile of the customer (column 26, lines 30-33). Note that the reference collects information as to the access by customers and uses this information in profiling.

Given the teaching of Slotznick (USPN 6,108,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Shiota et al. (USPN 6,337,712) by employing the obtaining of customer information during use to build or add on to an existing customer profile. This would allow the system to more quickly present user preferences and to keep statistical information as to usage in different locations. This specialized information will allow for targeted advertising and faster service for customers.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gutman et al. (WO 92/11598), Borgstahl et al. (USPN 6,421,347) and May (USPN 6,421,635) teach systems for user remote access. The systems of Borgstahl et al. and Gutman et al. are based on wireless connection of portable and stationary devices. The system of May includes the use and manipulation of a user profile.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (703)306-0543. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703)305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-9242 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Kevin Parton
Examiner
Art Unit 2153

ksp
August 5, 2002

A handwritten signature in black ink, appearing to read 'Dung C. Dinh', with a long, sweeping horizontal line extending to the right.

Dung C. Dinh
Primary Examiner